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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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|------------------------|---|
| Proceeding | 91178864 |
| Party | Plaintiff ILSI Health and Environmental Sciences Institute |
| Correspondence Address | Shawn N. Sullivan ILSI Health and Environmental Sciences Institute One Thomas Circle, NW9th Floor Washington, DC 20005-5802 UNITED STATES ssullivan@ilsi.org |
| Submission | Answer to Counterclaim |
| Filer's Name | Shawn N. Sullivan |
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| Date | 11/08/2007 |
| Attachments | HESI Answer to Elsevier Counterclaim.pdf (4 pages)(57111 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ILSI HEALTH AND
ENVIRONMENTAL SCIENCES
INSTITUTE,

Opposer

v.

ELSEVIER INC.

Applicant

§ Opposition No. 91178864

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Serial No. 76/651,527

**OPPOSER’S ANSWER TO APPLICANT’S COUNTERCLAIM
FOR PARTIAL CANCELLATION**

Opposer and Counterclaim Defendant, ILSI Health and Environmental Sciences Institute (“Opposer”), hereby answers Applicant Elsevier, Inc.’s (“Applicant’s”) Counterclaim for Partial Cancellation as follows:

1. Opposer denies the allegations contained in the unnumbered paragraph immediately preceding the numbered paragraphs of the Counterclaim, which appears on pages 2-3 of Applicant’s Answer to Notice of Opposition and Counterclaim for Partial Cancellation.

2. Opposer is without information sufficient to form a belief as to the truth of the allegations of Paragraph 1 of the Counterclaim, and therefore denies the same.

3. Opposer admits that Applicant has filed Application Serial Number 76/651,527 to register the mark HESI for the goods and services identified in Paragraph 1 of the Counterclaim in International Classes 41, 42, and 35. Opposer further admits that Applicant’s application was approved for publication by the Trademark Office and was

published for opposition on February 13, 2007. Except as so admitted, Opposer denies the allegations of Paragraph 2 of the Counterclaim.

4. Opposer admits that it was issued on December 20, 2005, Registration No. 3,032,209, with a date of first use and first use in commerce of 1989. Opposer further admits that Registration No. 3032209 was granted on and in connection with the following goods and services in International Classes 16, 36, and 41:

Printed publications, namely, newsletters, books, magazines, pamphlets, journals, monographs, white papers, brochures, printed articles, catalogs, printed supplements, printed agendas, directories, posters, informational flyers, printed announcements, reports, studies, reviews, folders, calendars, bulletins, and treatises in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health.

Providing research grants in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health.

Educational services, namely, arranging, organizing, and conducting symposiums, workshops, and conferences in the fields of toxicology, risk assessment, safety assessment, the environment, pathology, and health.

Except as so admitted, Opposer denies the allegations of Paragraph 3 of the Counterclaim.

5. Opposer admits that it has filed an opposition to Applicant's registration application. The contents of Opposer's opposition are incorporated by reference into this answer. Opposer further admits that one of the grounds on which Opposer has opposed Applicant's registration application is a likelihood of confusion. Except as so admitted, Opposer denies the allegations of Paragraph 4 of the Counterclaim.

6. Opposer denies the allegations of Paragraph 5 of the Counterclaim.

7. Opposer denies the allegations of Paragraph 6 of the Counterclaim.

8. Opposer denies the allegations of Paragraph 7 of the Counterclaim.

9. Opposer denies the allegations of Paragraph 8 of the Counterclaim.
10. Opposer denies the allegations of the “Prayer for Relief” contained in the Counterclaim and denies that Applicant is entitled to any relief at all.

Affirmative Defenses

1. Applicant has failed to state a claim upon which relief may be granted.
2. The relief sought by Applicant is barred by the doctrines of estoppel, laches, and/or acquiescence.

WHEREFORE, Opposer prays that the Counterclaim for Partial Cancellation filed by Elsevier, Inc. be dismissed in its entirety; that Application Serial Number 76/651,527 be denied; and for such other relief as may be deemed just and proper.

Respectfully submitted via ESTTA, this the 8th day of November, 2007.

ILSI HEALTH AND ENVIRONMENTAL
SCIENCES INSTITUTE

By: /Shawn N. Sullivan
Shawn N. Sullivan

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Defendant

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Opposer's Answer to Applicant's Counterclaim for Partial Cancellation was served via first-class mail, postage prepaid, and by e-mail today, November 8, 2007, upon the following persons:

Rodrick J. Enns, Esquire
Enns & Archer LLP
939 Burke Street
Winston-Salem, NC
27101

/Shawn N. Sullivan/

Shawn N. Sullivan